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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,415

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Naoto Ohshima

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06/06/2006

SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

LETSCHER, GERALDINE

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/798,415

Applicant(s)

OHSHIMA ET AL.

Examiner

Geraldine V. Letscher

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,12 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,12 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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This office action is responsive to the amendment filed March 13, 2006. Claims 3-11 and 13-29 have been canceled. Claim 36 has been added. Claims 1, 2, 12 and 30-36 are pending and presently under consideration. The base independent claim 1 has been amended to more particularly claim the instant invention by reciting the average electron releasing time of each of the at least one metal complexes, and by reciting the said at least two metal complexes each have at least two kinds of ligands.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1,2,12 and 30-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (amended) is rejected as being vague and indefinite when it recites "metal complexes each having at least two *kinds of ligands*" (emphasis added). The phrase "kinds of" renders the claim indefinite. The ligands encompassed by "kinds of" is unascertainable. Claim 1 fails to particularly point out and distinctly claim that the metal complexes each have at least two different ligands.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-17, 22,25,29 and 30-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Sato et al. (U.S. Patent No. 6,638,702).

Sato et al. discloses:

(a) a silver halide emulsion comprising a silver halide grain containing at least two metal complexes each giving an average electron releasing time inclusive of the instant claim 1, wherein two of said at least two metal complexes are a first metal complex and a second metal complex having at least three times longer average electron releasing time than that of the first metal complex, and the molar ratio of the amount of the first metal complex to that of the second metal complex is at least three times (please refer to the examples for the molar ratio);

(b) a silver halide emulsion comprising a silver halide grain containing at least two metal complexes each giving an average electron releasing time inclusive of the instant claim 2, said at least two metal complex each having at least one organic ligand, wherein two of said at least two metal complexes are a first metal complex and a second metal complex having at least three times longer average electron releasing time than that of the first metal complex;

© a silver halide emulsion comprising a silver halide grain, the silver halide grain containing at least three metal complexes each giving an average electron releasing time of inclusive of the instant claim 5.

*The average electron releasing time of the metal complexes in Class C are within the presently claimed range of  $10^{-5}$  to less than  $10^{-2}$  seconds. The average electron releasing time of the metal complexes in Class B are within the presented claimed range of  $10^{-2}$  to 3 seconds. The metal complexes each have at least two different ligands.*

The applied reference has a common assignee/inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

5. Claims 1-17, 22,25,29 and 30-35 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 10/642,583 (corresponding to U.S. Patent Application Publication No. 2004/0058285) by Sato et al. which has a common assignee/inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C.

102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

Sato et al. discloses:

(a) a silver halide emulsion comprising a silver halide grain containing at least two metal complexes each giving an average electron releasing time inclusive of the instant claim 1, wherein two of said at least two metal complexes are a first metal complex and a second metal complex having at least three times longer average electron releasing time than that of the first metal complex, and the molar ratio of the amount of the first metal complex to that of the second metal complex is at least three times (please refer to the examples for the molar ratio);

(b) a silver halide emulsion comprising a silver halide grain containing at least two metal complexes each giving an average electron releasing time inclusive of the instant claim 2, said at least two metal complex each having at least one organic ligand, wherein two of said at least two metal complexes are a first metal complex and a second metal complex having at least three times longer average electron releasing time than that of the first metal complex;

© a silver halide emulsion comprising a silver halide grain, the silver halide grain containing at least three metal complexes each giving an average electron releasing time of inclusive of the instant claim 5.

*The average electron releasing time of the metal complexes in Class C are within the presently claimed range of  $10^{-5}$  to less than  $10^{-2}$  seconds. The average electron*

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*releasing time of the metal complexes in Class B are within the presented claimed range of  $10^{-2}$  to 3 seconds. The metal complexes each have at least two different ligands.*

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,638,702.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn to essentially the same invention; please refer to preceding paragraph 4.

8. Claims are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/642,583. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn to essentially the same invention; please refer to preceding paragraph 5.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Response to Arguments***

9. Applicants arguments consist of statements to the effect that the prior art of record does not disclose the invention as is now claimed, further limited by the insertion of the average electron releasing times, and requiring the metal complexes to have at least two different ligands. The range of 0.001 to 0.1 is within the claimed range of 0.00001 to 0.01; the range of 0.1 to 100 overlaps with the claimed range of .01 to 3.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V. Letscher whose telephone number is (571) 272-1334. The examiner can normally be reached 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
GERALDINE LETSCHER  
PRIMARY EXAMINER  
GROUP 1100